



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,852	07/31/2003	Jonnie R. Williams	004859.00044	1976
22907	7590	05/23/2006		
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001				
EXAMINER MAYES, DIONNE WALLS				
ART UNIT		PAPER NUMBER		
1731				

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/630,852	<b>Applicant(s)</b> WILLIAMS, JONNIE R.	
	<b>Examiner</b> Dionne Walls Mayes	<b>Art Unit</b> 1731	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3,5-14 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-14 and 16-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Withdrawal of Previously-Indicated Allowable Subject Matter/Re-Opening of Prosecution***

1. After reconsidering updating a search of the prior art of, the Examiner has determined that a new ground of rejection should be made, based on the Lofman reference, over the claims as filed on May 11, 2006. Therefore, the FINALITY of the rejection of the last Office Action, dated February 15, 2006, and the indication of allowable subject matter has been WITHDRAWN. In view of the discovery of the above-cited art, PROSECUTION IS HEREBY REOPENED as set forth below.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3, 5-14, 16-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has recited the term "bit" (as in the phrase "a solid bit"); however, it is not clear what exactly is encompassed by this term as it is not sufficiently defined in the instant specification. The examiner believes that the term may mean a compressed tobacco powder in the form of a disc or wafer or tablet, but the written specification does not make this abundantly clear. For purposes of Examination, the Examiner will construe the term "bit" to mean tobacco powder which has been compressed, and is in a solid or compacted form (such as a wafer or tablet); however, it is not believed that

Art Unit: 1731

this interpretation is entirely consistent or disclosed by the instant specification.

Clarification is requested.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5,9,10,12-14,16,20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lofman (US. Pat. No. 6,135,120) in view of Dusek et al (US. Pat. No. 4,606,357).

Lofman discloses compressed snuff portions (corresponding to the claimed "solid bit of powdered tobacco"). While Lofman may not specifically state that the snuff comprises added flavoring which comprises the claimed weight percentage of peppermint, menthol and/or wintergreen/spearmint, it would have been obvious to one having ordinary skill in the art at the time of the invention to have added the flavorants since these flavors are conventionally used in manufacturing snuff, as is evidenced by the Dusek et al reference (See col. 4, line 65-66). One having ordinary skill in the art would have arrived at the claims percentages, after routine experimentation, in order to optimize the flavor content of the snuff to provide the user with a pleasing taste.

Regarding claims 9 and 20, it would have been obvious to one having ordinary skill in the art at the time of the invention to have provided tobacco which is of the

Art Unit: 1731

Virginia flue-cured variety since such is a common type of tobacco used in tobacco-based articles.

6. Claims 6-8, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lofman (US. Pat. No. 6,135,120) in view of Dusek et al (US. Pat. No. 4,606,357), further in view of WO 00/15056.

While Lofman modified by Dusek et al may not specifically disclose that the powdered tobacco comprising its snuff product has the claimed nitrosamine content, WO 00/15056 discloses a tobacco product, comprised from Virginia flue-cured tobacco leaves, which can be converted to a smokeless tobacco product which has a combined TSNA (corresponding to the claimed "collective content of NNN, NNK, NAT, NAB") as low as less than about .009 micro g/g (corresponding to the claimed "0.3/0.2/0.1 micro g/g or less") (see pages 28 and 29). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have provided the tobacco-based (smokeless) product of Lofman modified by Dusek et al with the nitrosamine content disclosed in WO 00/15056, in order to provide a less-carcinogenic tobacco product as taught in WO 00/15056.

### ***Conclusion***

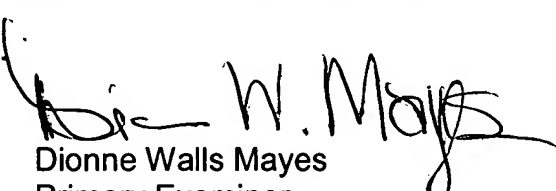
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne Walls Mayes whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone

Art Unit: 1731

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dionne Walls Mayes  
Primary Examiner  
Art Unit 1731

May 19, 2006